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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,855	12/15/2005	Masaya Yamamoto	2005_1982A	2096
52349 7590 10/15/2008 WENDEROTH, LIND & PONACK L.L.P. 2033 K. STREET, NW SUITE 800 WASHINGTON, DC 20006			EXAMINER COPPOLA, JACOB C	
			ART UNIT 3621	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/560,855	<b>Applicant(s)</b> YAMAMOTO ET AL.	
	<b>Examiner</b> JACOB C. COPPOLA	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>15 December 2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This action is in reply to the Restriction Election filed on 18 August 2008.
2. Claims 1-13 are currently pending and have been examined.
3. All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. Applicants’ election without traverse of claims 6-13 in the reply filed on 18 August 2008 is acknowledged.
5. Claims 1-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
6. This Office Action is given Paper No. 20081008. This Paper No. is for reference purposes only.

### ***Priority***

7. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 19 November 2003. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

***Information Disclosure Statement***

8. The Information Disclosure Statement filed on 15 December 2005 has been considered.

An initialed copy of the Form 1449 is enclosed herewith.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 8-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. Regarding claims 8-13:

a. The contents reproduction device of claim 8 comprises a “license management section” and a “license lock section”. In the broadest reasonable interpretation, these components could be interpreted to be software. Software, computer implemented applications, programs, code, etc. are not statutory subject matter. Alternatively, processes and “computer-executable programs tangibly embodied on a computer readable medium” may be considered statutory subject matter under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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13. Claims 6-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

14. Regarding claims 6 and 7:

b. These claims recite “[a] contents reproduction method”. One of ordinary skill in the art would not be able to determine the steps of the claimed method. Accordingly claims 6 and 7 are indefinite.

15. Regarding claims 8-13:

c. These claims recite “the license management means”. These claims are indefinite because this phrase lacks antecedent basis.

16. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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18. Claims 6-9, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Clisham et al. (U.S. 2004/0168052 A1) (“Clisham”), in view of Vilcauskas et al. (U.S. 2002/0152874 A1) (“Vilcauskas”).

19. Regarding claims 6 and 8:

d. Clisham discloses the following limitations:

- i. *A contents reproduction device (client device 200) for reproducing contents data containing a plurality of resources (“multiple encoded segments”) (fig. 2 and associated text; ¶0081);*
- ii. *wherein the plurality of resources (“multiple encoded segments”) each comprise at least one main resource including a main part of contents (“encoded body portion”); and*
- iii. *a plurality of sub resources including related information associated with the main part (“header”) (fig. 2 and associated text; ¶0081).*

e. Clisham is not believed to directly disclose the following limitations:

- iv. *using license data corresponding to the contents data; and*
- v. *the contents reproduction device comprising:*
  - (1) *a license management section operable to manage license data;*
  - and*
  - (2) *a license lock section operable to cause the license management means to lock license data corresponding to contents data to be reproduced, only when a computer starts a reproduction of the main resource.*

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f. Vilcauskas, however, discloses a contents reproduction device (server **20**) that uses license data (“license”) corresponding to contents data (“song or album”) (§0024), the contents reproduction device comprising:

(3) *a license management section operable to manage license data (§0024); and*

(4) *a license lock section operable to cause the license management means to lock license data corresponding to contents data to be reproduced, only when a computer starts a reproduction of the main resource (§0024).*

g. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the device of Clisham to include the license management and license lock features of Vilcauskas. One would have been motivated to do so because “the owners of any copyrights in the audio content are compensated for their contribution because only one digital copy, albeit compressed, of that content which was obtained by the provider **34** is provided to any user at any particular time” (Vilcauskas, §0024).

20. Regarding claims 7 and 9:

h. Clisham/Vilcauskas discloses the limitations of claims 6 and 8, as described above. Clisham/Vilcauskas, further, discloses the limitations:

vi. *only when terminating a reproduction of the main resource, a license lock releasing section operable to notify the license management section that the reproduction of the main resource is terminated, and causing the license*

*management section to release a lock of license data corresponding to the contents data to be reproduced, and to update use situation information within license data (Vilcauskas, ¶0025).*

21. Claims 10, 11, and 13, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Clisham/Vilcauskas, in further view of Gould et al. (U.S. 6,393,158 B1) (“Gould”).

22. Regarding claims 10 and 11:

i. Clisham/Vilcauskas discloses the limitations of claim 8, as described above.

Clisham/Vilcauskas, further, discloses the limitations:

vii. *further comprising a resource reproduction section (client device **200**) for reproducing each of the resources (Clisham, ¶0081);*

viii. *wherein the plurality of sub resources are encrypted (Clisham, ¶0081), the resource reproduction section including:*

(5) *a main resource reproduction section (client device **200**) operable to reproduce the main resource (Clisham, ¶0081; fig. 2 and associated text); and*

(6) *a sub resource reproduction section (client device **200**) operable to reproduce the sub resource (Clisham, ¶0081; fig. 2 and associated text);*

ix. *the sub resource reproduction section includes:*

(7) *a decryption section operable to decrypt the plurality of sub resources collectively (Clisham, ¶0081; fig. 2 and associated text);*



(8) *a cache section operable to temporarily store a sub resource which is decrypted by the decryption section (Clisham, ¶0081; fig. 2 and associated text); and*

(9) *a decoding section operable to reproduce the sub resource by using the decrypted sub resource, which is stored in the caches section (Clisham, ¶0081; fig. 2 and associated text).*

j. Clisham/Vilcauskas is not believed to directly disclose the following limitations:

x. *a plurality of resource reproduction sections.*

k. Gould, however, teaches the limitations:

xi. *a plurality of resource reproduction sections (C4, L19-36).*

l. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the combined system of Clisham/Vilcauskas to include a plurality of resource production sections as disclosed by Gould in order to prepare the system of Clisham/Vilcauskas to reproduce audio/video content instead of only audio.

23. Regarding claim 13:

m. Clisham/Vilcauskas/Gould discloses the limitations of claim 11, as described above. Clisham/Vilcauskas/Gould, further, discloses the limitations:

xii. *wherein the plurality of sub resources are collectively further compressed (Gould, C1 and C2), and the decryption section decrypts the plurality of sub resources, extracts the compressed sub resources, and temporarily stores the*

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*extracted and encrypted sub resources in the caches section* (Clisham, ¶0081; fig. 2 and associated text).

24. Claim 12, as understood by the Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Clisham/Vilcauskas/Gould, and in further view of Official Notice.

25. Regarding claim 12:

n. Clisham/Vilcauskas/Gould discloses the limitations of claim 11, as described above. Clisham/Vilcauskas/Gould is not believed to directly disclose the limitations:

xiii. *wherein at least the decryption section is tamper resistant.*

o. However, the Examiner takes Official Notice that tamper resistant hardware and tamper resistant software is old and well-known in the art because this allows protection over proprietary products.

p. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the decryption section of Clisham/Vilcauskas/Gould to be tamper resistant in order promote anti-piracy.

26. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the

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claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

27. In light of Applicants' choice to pursue product claims, Applicants are reminded that functional recitations using the word and/or phrases "for", "adapted to", "configured to", or other functional language (*e.g.* see claim 8 which recites "a content reproduction device for reproducing contents data containing a plurality of resources") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

28. Regarding the conditional elements in the claims (see *e.g.* claim 8 which recites that "a license lock section operable to cause the license management means to lock license data... only when a computer starts a reproduction" [emphasis added]), they too have been considered. However, Applicants are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a

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particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”

29. Although Applicants use “means to” in the claim (*e.g.* see claim 8 which recites “means to lock”), it is the Examiner’s position that the “means to” phrase does not invoke 35 U.S.C. 112, 6<sup>th</sup> ¶ because the claim limitation fails prong 1 of the “3-prong analysis” for determining whether a claim limitation invokes 35 U.S.C. 112, 6<sup>th</sup> ¶ (i.e. the claim does not use “means for” language) (MPEP §2181).

30. Using the broadest reasonable interpretation, the following definitions are relied upon by the Examiner when interpreting claim language:

q. ***operable*** “1: fit, possible, or desirable to use”. (Webster’s Ninth New Collegiate Dictionary, Merriam-Webster, Inc., Springfield, MA, 1986)

### ***Conclusion***

31. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as

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discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

32. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C. Coppola/  
Patent Examiner, Art Unit 3621  
October 8, 2008

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621